

Amendment and Response

Page 14 of 17

Serial No.: 09/640,952

Confirmation No.: 3252

Filed: 17 August 2000

For: EPHA2 AS A DIAGNOSTIC TARGET FOR METASTATIC CANCER

Remarks

The Office Action mailed 23 December 2005 has been received and carefully reviewed. Claims 21 and 23 having been amended, the claims pending and under consideration are claims 1, 3-13, 21, 23, 24, 33, 36, 37, 41-47, 49-56, 59-68, 72, 73, 75-81, 90-101. Reconsideration and withdrawal of the rejections are respectfully requested.

The amendment of claim 21 to recite "wherein said reagent comprises a nucleic acid that is complementary to the nucleic acid coding for EphA2 protein" is supported by, for example, the observation that it is well-known in the art that nucleic acids can hybridize to complementary nucleic acids, and further by the specification at page 2, lines 29-30, and page 5, lines 28-30.

Rejection Under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 21, 23 and 24 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner maintains that the claims do not provide a structural limitation for a "reagent" capable of binding to a nucleic acid coding for a EphA2 protein (claim 21).

This rejection is respectfully traversed. However, in order to advance prosecution, claim 21 has been amended to recite "wherein said reagent comprises a nucleic acid that is complementary to the nucleic acid coding for EphA2 protein." As noted by the Examiner, the art teaches that nucleic acids can hybridize to complementary nucleic acids. Further, the specification teaches "diagnostic reagent specific for detecting EphA2, any fragment thereof, or DNA or RNA coding for the EphA2 protein" (specification at page 2, lines 29-30) and that "[o]ther methods of detecting altered EphA2 expression include detecting DNA or RNA sequences coding for the EphA2 protein" (specification at page 5, lines 28-30).

Claim 23 is amended in view of the amendment to claim 21, in order to clarify that it is the nucleic acid coding for EphA2 protein that is the "DNA or RNA" recited in the claim.

Amendment and Response

Page 15 of 17

Serial No.: 09/640,952

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Reconsideration and withdrawal of the rejection of claims 21, 23 and 24 under 35 U.S.C. §112, first paragraph is respectfully requested.

Rejection under 35 U.S.C. §103(a)

The Examiner rejected claims 1, 3-8, 10, 11, 13, 33, 36, 37, 41, 42, 45, 47, 49, 55, 56, 59-65, 68, 72, 73, 75, 76, 78, 79, 80, 90, 91 and 97 under 35 U.S.C. §103(a) as being unpatentable over Zantek et al. (Molecular Biology of the Cell 1998;9(suppl):134A as evidenced by the abstract of Chen et al. (J of Biological Chemistry 1998;273:24670-24675) in view of Larrick et al. (In: Human Hybridomas and Monoclonal Antibodies, Engleman and Foug, Eds., 1985:8-9) and Campbell (Monoclonal Activity Technology 1985;1-32) and Lindberg et al. (Molecular and Cellular biology;1990;10:6316-6316).

The Examiner further rejected claims 1, 3-8, 10-13, 33, 36, 37, 41, 42, 45-47, 49, 55, 56, 59-65, 68, 72, 73, 75, 76, 78, 79, 80, 90, 91 and 97 under 35 U.S.C. 103(a) as being unpatentable over the abstract of Zantek et al., the abstract of Chen et al., Larrick et al., Campbell and Lindberg et al. as applied to claims 1, 3-8, 10, 11, 13, 33, 36, 37, 41, 42, 45, 47, 49, 55, 56, 59-65, 68, 72, 73, 75, 76, 78, 79, 80, 90, 91 and 97 above and further in view of Pendergast et al. (WO 97/15587).

The Examiner further rejected claims 1, 3-11, 13, 33, 36, 37, 41-45, 47, 49, 55, 56, 59-68, 72, 73, 75, 76, 78, 79, 80, 90, 91 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over the abstract of Zantek et al., the abstract of Chen et al., Larrick et al., Campbell and Lindberg et al. as applied to claims 1, 3-8, 10, 11, 13, 33, 36, 37, 41, 42, 45, 47, 59, 55, 56, 59-65, 68, 72, 73, 75, 76, 78, 79, 80, 90, 91, and 97 above, and further in view of the abstract of Terstappen et al. (Vox Sanguinis, 1998, 74(suppl 2):269-274)

The Examiner further rejected claims 47, 51-53, 55, 56, 59-65, and 68 under 35 U.S.C. 103(a) as being unpatentable over the abstract of Zantek et al. (Molecular Biology of the Cell 1998;9:suppl:134A) as evidence by the abstract of Chen et al. (J. of Biological Chemistry, 1998;273:24670-24675) in view of Larrick et al. and Campbell.

Amendment and Response

Page 16 of 17

Serial No.: 09/640,952

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The Examiner rejected claims 21 and 23 under 35 U.S.C. 103(a) as being unpatentable over the abstract of Zantek et al. (Molecular Biology of the Cell, Nov 1998, 9(suppl):134A as evidenced by the abstract of Chen et al. (J. of Biological Chemistry 1998;273:24670-24675), in view of Lindberg et al. (Molecular and Cellular Biology 1990;10:6316-6316) and Hoon et al. (U.S. Patent No. 6,057,105).

The Examiner rejected claims 21, 23 and 24 under 35 U.S.C. 103(a) as being unpatentable over the abstract of Zantek et al., the abstract of Chen et al., Lindberg et al. and Hoon et al. as applied to claims 21 and 23 above, and further in view of Wittwer et al. (U.S. Patent No. 6,174,670).

The rejections under 35 U.S.C. §103(a) are respectfully traversed.

It is respectfully submitted that the primary reference, Zantek et al. (Molecular Biology of the Cell 1998;9(suppl):134A) has been removed as prior art.

Applicants respectfully direct the Examiner's attention to the "In re Katz Declaration Under 37 C.F.R. §1.132" of Michael S. Kinch (Kinch Declaration), executed October 4, 2001, (Exhibit A) as well as accompanying remarks transmitted with Applicants' Amendment and Response mailed October 5, 2001. The Kinch Declaration was submitted in response to previously raised rejections under 35 U.S.C. §103(a). These rejections were subsequently withdrawn as indicated in the Office Action mailed January 2, 2002.

In view of the removal of Zantek et al. as prior art, reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a) is respectfully requested.

Amendment and Response

Page 17 of 17

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Summary

It is respectfully submitted that the pending claims 1, 3-13, 21, 23, 24, 33, 36, 37, 41-47, 49-56, 59-68, 72, 73, 75-81, 90-101 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

By

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 23rd day of May, 2006, at 4:50pm (Central Time).

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